



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application entitled: INVERTER CIRCUITS  
Applicant: Ole K. Nilssen  
Serial No: 06/787,692  
Filed: 10/15/85  
Group Art Unit: 212  
Examiner: BEHA, WILLIAM H.

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APR 9 1986  
DIRECTOR, GROUP 210

# 44  
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APR 07 1986  
GROUP 210  
Boulton  
4/14/86

AMENDMENT A

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Pursuant to letter from Director of Group 210 dated 03/26/86, Applicant herewith provides the following sanitized response to Office Action dated 12/09/85.

COMMENTS RE PROCEDURE AND AUTHORITIES

For purpose of convenient reference, Applicant herewith identifies the following provision from Manual of Patent Examining Procedure (MPEP). (The underlining is provided by Applicant.)

706.02: "After indicating that the rejection is under 35 U.S.C. 103, there should be set forth (1) the difference or differences in the claim over the applied reference(s), (2) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (3) an explanation why such proposed modification would be obvious"

Also, Applicant directs Examiner's attention to the following quotations from various court interpretations (Authorities) in respect to patentability under 35 U.S.C. 103. Several of these Authorities (#1-#6) were provided to Applicant by the Assistant Commissioner for Patents and represented by him as being the Authorities relied upon by the PTO in determining patentability under 35 U.S.C. 103.

#1. "patentable invention may lie in discovery of source of problem even though remedy may be obvious once source of problem is identified" (In re Sponnoble, 405 F.2d 578, 160 USPQ 237, 1969);

#2. "A patentable invention within the ambit of 35 U.S.C 103 may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the result inherent in their use" (In re Sponnoble, 405 F.2d 578, 160 USPQ 243, 1969);

#3. "Where unobvious aspect of invention resides in recognition of source of problem, Patent Office inquiries should be directed, in part at least, to question of whether such a recognition would have been obvious to one of ordinary skill in the art; inquiry must go beyond the nature of the solution" (In re Roberts, 470 F.2d 1399, 176 USPQ 313, 1973);

#4. "we also believe that a more proper, albeit not exclusive, inquiry in a case such as this is to look further as to the reasons for making the combination" (In re Sponnoble, 405 F.2d 578, 160 USPQ 243, 1969);

#5. "If there is no evidence that a person of ordinary skill in the art at time of applicant's invention would have expected problem to exist at all, it is not proper to conclude that invention which solves this problem, which is claimed as an improvement of prior art device, would have been obvious to that hypothetical person". (In re Nomiya, 184 USPQ 608, 1975)

#6. "There must be a reason apparent at time invention was made to person of ordinary skill in the art for applying the teaching at hand, or use of teaching as evidence of obviousness will entail prohibited hindsight". (In re Nomiya, 184 USPQ 608, 1975)

#7. Application of Miller (57 CCPA 809, 418 F2d 1392, 164 USPQ 46) affirming the patentability of a "new use of a known process, machine, manufacture, composition of matter, or material".

#8. In re Gordon (221 USPQ 1125 -- Fed. Cir. 1984), especially as discussed in an article by Alton D. Rollins (Primary Examiner, Art Unit 129) in the May (1984) issue of Journal of the Patent Office Society.